

REMARKS/ARGUMENTS

Claims 14-34 are active. Independent Claim 14 has been amended to refer to a nucleic acid comprising a ribosome binding site comprising GAAGGA (SEQ ID NO: 3). Support for this amendment is found in the specification on page 5, see e.g., last two lines.

The Applicants thank Examiners Walicka and Prouty for the courteous interview of October 22, 2003 and for their helpful remarks which help to further clarify the claim language. To better describe the D-aminoacylase gene, it was suggested that claims be amended to refer to a sequence of native restriction sites (Sal I, Bgl II and Pvu II) shown in Fig. 2. For clarity and consistency, the Applicants were advised to change the word "tolerance" in Claims 21 and 22 to "resistance", and to address the enablement and description rejections, it was suggested that the term "expression" in the last clause of independent Claim 14 be replaced with the term "activity". To address the prior art rejection over Wakayama, Biosci. Biotech. Biochem. 59:2115, it was suggested that Claims 28 and 32 might be amended to require a specific ribosome binding site such as GAAGGA. These amendments have now been made, accordingly, favorable consideration is now respectfully requested.

Objections

The specification (page 11, line 11 of the substitute specification) was objected to under 35 U.S.C. § 132 as introducing new matter for inclusion of the term "Sau3AI". Certain terms in the original specification were underlined and may appear to have been added subject matter in the substitute specification. However, the Applicants note that this term is an original term appearing in the specification on page 9, line 16. Accordingly, this objection may now be withdrawn.

Claim 19 was also objected to as lacking the word “by”. This objection is moot in view of the amendment of this claim.

Rejection – 35 U.S.C. § 112, second paragraph

Claims 14, 17-27 and 28-34 were rejected under 35 U.S.C. 112, second paragraph, as being indefinite. The Applicants submit that these rejections are moot in view of the amendment of the claims. The phrase “the following sequence of restriction sites: Sal I – Bgl II – Pvu II” should be interpreted as referring to a nucleic acid sequence which contains within its bounds these three restriction sites as shown, for instance, in Fig. 2. However, it is not to be construed as requiring that each of these restriction site recognition sequences be immediately adjacent to each other. That is, each recognition site may have a longer sequence of nucleotides between it and the next recited recognition site.

Rejection - 35 U.S.C. § 112, first paragraph

Claims 14-27 were rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not adequately described. The Applicants submit that these rejections are moot in view of the amendment of Claim 14 to recite the term “activity” instead of “expression”. The term “activity” is described, for instance, at page 14, line 8-page 15 of the specification.

Rejection - 35 U.S.C. § 112, first paragraph

Claims 14, 17-27 and 32-34 were rejected for lack of adequate written description. This rejection is moot in view of the amendment of the restriction sites to correspond to those shown in original Fig. 2. Claim 30 has been revised to refer to an upstream EcoR I site and a downstream Hind III site as also shown in Fig. 2.

Rejection – 35 U.S.C. § 112, first paragraph

Claims 14 and 17-28 were rejected under 35 U.S.C. § 112, first paragraph, as lacking adequate enablement. This rejection is moot in view of the amendment of the restriction sites to correspond to those shown in original Fig. 2. Also, as discussed in the interview, the Applicants submit that one with skill in the art would be able to identify other D-aminoacylase genes from *Alcaligenes* based on this sequence of three restriction sites. Accordingly, the Applicants respectfully request that this rejection be withdrawn.

Rejection – 35 U.S.C. § 102

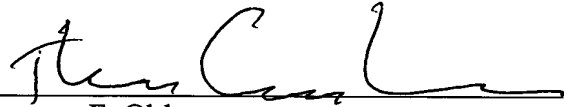
Claims 28, 29 and 32-34 were rejected under 35 U.S.C. § 102(b) as being anticipated by Wakayama et al., Biosci Biotech Biochem. 59:2115. This rejection is moot in view of the amendment of the claims to include a ribosome binding site which is not disclosed by Wakayama et al.

CONCLUSION

In view of the above amendments and remarks the Applicants respectfully submit this application is now in condition for allowance. Early notification t that effect is earnestly solicited.

Respectfully submitted,

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